BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court is found on page 79a of the Record. The opinion of the Court of Appeals of the Second Circuit is included in the record sent to this Court, at the end thereof.

Jurisdiction.

The jurisdiction as to review is stated in the foregoing Petition.

Statement of Case.

The material facts necessary to an understanding of the reasons relied upon for granting the writ are contained in the foregoing Petition.

ARGUMENT.

POINT 1.

An affidavit under Rule 75 shifts the burden of proof.

The practice under Rule 75 is well established in the Patent Office and has received the sanction of the courts. *Deering v. Winona Harvester Works,* 155 U. S. 286; *Pullman's Palace Car Co. v. Boston, etc., R. R.,* 44 F. 195.

In the *Deering* case, Justice Brown stated as to the proof introduced by the plaintiff to antedate a foreign

patent that "his oath was accepted by the Patent Office as decisive of the fact."

The reasonable presumption of validity furnished by the grant of a patent on the basis of an affidavit under Rule 75 is not destroyed except by convincing evidence, and the burden of proof should remain on the defendant. *Corona Co. v. Dovan Corp.*, 276 U. S. 358.

Justice Bradley, in *Miller v. Brass Co.*, 104 U. S. 350, held that when a patent does not claim an invention, it is either not the patentee's invention, or, if his, he dedicates it to the public. Note *Alvord v. Smith, et al.*, 216 F. 150 at 160.

It is submitted that the burden of proof, when the validity of a patent is attacked on the basis of a reference overcome by an affidavit under Rule 75, rests on the defendant, and not on the plaintiff.

POINT 2.

An antedated prior patent is not a valid reference.

The Circuit Court of Appeals for the Ninth Circuit, in *Willamette-Hyster Co. v. Pacific Car and Foundry Co.*, 122 F. (2) 492, refused to consider a cited reference which had been overcome by an affidavit under Rule 75, as a valid reference. The Fourth Circuit similarly held in affirming Judge Rose in *Thacher v. Mayor*, 230 F. 1022.

The decision in the case here in issue held the opposite view. In neither decision was evidence presented attacking the affidavit.

POINT 3.

The acceptance of an affidavit under Rule 75 is an adjudication of priority.

The acceptance of an affidavit under Rule 75 by the Patent Office, antedating a cited reference, is an adjudication on priority as to the cited reference. The oath is decisive as to the fact of antedating. *Deering v. Winona,* cited.

In this case, the issue of priority has been settled by a special tribunal, the Patent Office, entrusted with full power in the premises. *Morgan v. Daniels,* 153 U. S. 120 at 124; *United States v. Bell Telephone,* 167 U. S. 224 at page 267; *United States v. Duell,* 172 U. S. 576; *Steinmetz v. Allen,* 192 U. S. 543.

It is submitted that the Patent Office decision accepting an affidavit under Rule 75 is an adjudication of priority of invention as to the cited application.

POINT 4.

The acceptance of an affidavit under Rule 75 involves an exercise of discretion.

The issue of a patent upon the acceptance of an affidavit under Rule 75 involves an exercise of discretion by the Patent Office.

The rule requires the applicant to make oath to *facts* showing the completion of his invention in this country before the filing of the application on which the domestic patent issued. In the case in issue, such oath showing completion of the invention within the two-year period which then constituted a statutory bar, together with ad-

ditional evidence, was submitted and accepted. The rule requires consideration of the sufficiency of the facts; and thus requires an exercise of discretion by the Patent Office, more than the mere filing of the affidavit.

POINT 5.

The defendant should controvert the truth of the affidavit.

When the validity of a patent hinges on a reference which has been overcome by an affidavit under Rule 75, the burden should be on the defendant. *Corona Co. v. Dovan Corp.*, cited.

That this should be the rule is evident if a situation is considered, in which all the evidence has become lost, as in a fire, and all the witnesses have died. In such case, the patent would, on the basis of the decision herein requested reviewed, automatically become invalid in view of the prior cited reference. It is submitted that the burden should rest on the alleged infringer, to overcome the *prima facie* presumption of validity resulting from the acceptance by the Patent Office of the affidavit under Rule 75.

POINT 6.

Infringement exists where the substance of an invention has been appropriated.

The decision limited the invention to the specific construction disclosed in the patent, without consideration of the substance of the invention. The decision is, there-

fore, contrary to the rule stated by Mr. Justice Curtis in *Winans v. Dinmead,* 56 U. S. 330, p. 343:

> "Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention, for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement."

The United States Supreme Court has uniformly held that infringement is not avoided by a changed construction which appropriates all of the meritorious features of the appropriated invention. *Machine Co. v. Murphy,* 97 U. S. 120, 125; *Keystone Mfg. Co. v. Adams,* 151 U. S. 139, 145; *Hobbs v. Beach,* 180 U. S. 383, 398; *Busch v. Jones,* 184 U. S. 598; *Hildreth v. Mastoras,* 257 U. S. 27; *Continental Paper Bag Co. v. Eastern Paper Bag Co.,* 210 U. S. 405.

It is submitted that the substance of an invention must be considered when infringement is charged, and that changes from the specific construction illustrated in the patent, which achieve the same result in the same manner, do not avoid infringement.

Respectfully submitted,

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